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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,630	08/13/2001	Andreas Natsch	A 13470 US (C36368/125381)	8014
7590 04/05/2004				
Stephen M. Haracz, Esq. Bryan Cave, LLP 245 Park Avenue New York, NY 10167-0034			EXAMINER BADIO, BARBARA P	
			ART UNIT 1616	PAPER NUMBER

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,630

Applicant(s)

NATSCH, ANDREAS

Examiner

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

First Office Action on the Merits of a RCE

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2004 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1-4, 8, 9, 12-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorsky et al. (US 3,499,937).

Dorsky et al. teach compositions formed by hydrogenation of isocamphylguaiacols and the use of said compositions in perfume compositions (see the entire article, especially Examples I-VI). The compositions and process taught by the reference are encompassed by the instant claims.

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4. Claims 1-4, 12-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Darsow ('648).

Darsow teaches the production of isocamphylcyclohexanols by reaction of camphene with guaiacol in the presence of an acidic catalyst followed by hydrogenation (see the entire article, especially col. 1, lines 10-44; examples 1-3). The reference teaches the use of said industrial sandalwood perfumes in soaps, cosmetic products and perfume compounds (see especially col. 1, lines 10-15). The compositions and process taught by the reference are encompassed by the instant claims.

Note: After reevaluation of the above cited reference, the examiner feels a rejection is appropriate.

5. Claims 1-4, 12-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al. ('203).

Hall teaches perfume compositions and colognes containing catechol-camphene reaction products (see the entire article, especially col. 4, lines 7-59; col. 8, line 51-col. 9, line 67; Examples IV-XV). The compositions and process taught by the reference are encompassed by the instant claims.

Note: After reevaluation of the above cited reference, the examiner feels a rejection is appropriate.

Claim Rejections - 35 USC § 103

6. The rejection of claims 1-18 under 35 USC 103(a) over Darsow ('648), Hall et al. ('203) and Robinson et al. ('602) in combination is maintained.

Applicant's argument is that the process taught by Darsow does not teach the formulation of methoxylated isocamphylcyclohexanols as is claimed by the applicants. Applicant's argument was considered but not persuasive for the following reason.

Darsow teaches the reaction of camphene with guaiacol in the presence of an acidic catalyst followed by hydrogenation and the use of said mixture in preparation of soaps, cosmetics and perfume products. According to the present specification, said process results in a mixture of compounds which includes the claimed compounds. Thus, the composition utilized by Darsow would inherently contain the claimed compounds.

For this reason and those given in previous Office Actions, the rejection of claims 1-18 under 35 USC 103(a) over Darsow ('648), Hall et al. ('203) and Robinson et al. ('602) in combination is maintained.

7. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darsow ('648), Hall et al. ('203), Dorsky et al. ('937) and Robinson et al. ('602) in combination.

Darsow teaches the production of isocamphylcyclohexanols by reaction of camphene with guaiacol in the presence of an acidic catalyst followed by hydrogenation (see the entire article, especially col. 1, lines 10-44; examples 1-3). The reference

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teaches the use of said industrial sandalwood perfumes in soaps, cosmetic products and perfume compounds (see especially col. 1, lines 10-15). The compositions and process taught by the reference are encompassed by the instant claims.

Hall teaches perfume compositions and colognes containing catechol-camphene reaction products (see the entire article, especially col. 4, lines 7-59; col. 8, line 51-col. 9, line 67; Examples IV-XV). The compositions and process taught by the reference are encompassed by the instant claims.

Dorsky et al. teach compositions formed by hydrogenation of isocamphylguaiacols and the use of said compositions in perfume compositions (see the entire article, especially Examples I-VI). The compositions and process taught by the reference are encompassed by the instant claims.

Based on the combined teachings of the above cited references, the production of isocamphylcyclohexanols by reaction of camphene with guaiacol in the presence of an acidic catalysts followed by hydrogenation and the use of the mixture produced in soaps, cosmetic products, perfume compositions and colognes would have been obvious to the skilled artisan.

Claims 5, 6 and 8-10 differ from the references by reciting the incorporation of specific amounts of the compounds into compositions such as perfumes.

Claims 7, 10 and 17 differ from the references by reciting the addition of farnesol.

Claim 11 differ from the reference by reciting additional ingredients.

However, (a) the preparation of products as taught by the prior art using various amounts of the active ingredient(s) is routine in the art and, thus, within the level of skill

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of the ordinary artisan; (b) farnesol is a known bacteriostatic agent used in cosmetic products (see Robinson et al., col. 1, lines 53-58) and (c) the use of ingredient such as water and glycol in cosmetic compositions is well known in the art. Therefore, it would have been within the level of skill of the ordinary artisan in the art at the time of the present invention to make the products taught by the prior art utilizing various amounts of the composition taught by the cited references and, thus, various amounts of the claimed compounds, with the incorporation of various ingredients known to be useful in the cosmetic art in the preparation of said products. Based on the level of skill of the ordinary artisan in the art at the time of the invention and the teachings of the prior art, the claimed invention is prima facie obvious.

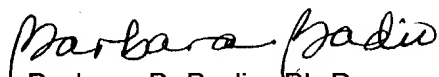
Telephone Inquiry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Barbara P. Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB

April 1, 2004